

ESTTA Tracking number: **ESTTA884850**

Filing date: **03/21/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|--|
| Name | MAJOR LEAGUE BASEBALL PLAYERS ASSOCIATION |
| Granted to Date of previous extension | 03/21/2018 |
| Address | 12 East 49th Street New York, NY 10017 UNITED STATES |
| Attorney information | Lori J. Shyavitz, Esq. MCCARTER & ENGLISH, LLP 265 FRANKLIN STREET BOSTON, MA 02110-3113 UNITED STATES Email: lshyavitz@mccarter.com, bostontrademarks@mccarter.com |

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 87528440 | Publication date | 11/21/2017 |
| Opposition Filing Date | 03/21/2018 | Opposition Period Ends | 03/21/2018 |
| Applicant | Michael P. Chisena P.O. Box 7169 Garden City, NY 11530 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Clothing, namely, t-shirts, shirts, shorts, pants, sweatshirts, sweatpants, jackets, jerseys, athletic uniforms, and caps

Grounds for Opposition

| | |
|---|------------------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
| Dilution by blurring | Trademark Act Sections 2 and 43(c) |
| False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute | Trademark Act Section 2(a) |
| Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse | Trademark Act Section 2(c) |

Mark Cited by Opposer as Basis for Opposition

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|------------------------------------|--|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | JUDGE | | |
| Goods/Services | Apparel, toys, video games, competitions in the field of baseball and other consumer products and services in the field of baseball. | | |

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| Attachments | Notice of Opposition - HERE COMES THE JUDGE.pdf(157961 bytes) |
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|-----------|------------------------|
| Signature | /Lori J. Shyavitz/ |
| Name | Lori J. Shyavitz, Esq. |
| Date | 03/21/2018 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 87/528,440
Published in the *Official Gazette* on November 21, 2017

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|--|--------|----------------------|
| MAJOR LEAGUE BASEBALL PLAYERS ASSOCIATION, | -----X | |
| | : | Opposition No. _____ |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | |
| | : | |
| MICHAEL P. CHISENA, | : | |
| | : | |
| Applicant. | : | |
| | -----X | |

NOTICE OF OPPOSITION

Opposer Major League Baseball Players Association, an unincorporated association operating under the laws of the State of New York with a principal place of business at 12 East 49th Street, New York, New York 10017 (“Opposer”) believes that it will be damaged by the registration of the trademark HERE COMES THE JUDGE set forth in Application Serial No. 87/528,440 (the “Application”), and hereby opposes same.

The grounds for the opposition are:

1. For more than fifty (50) years, Opposer has been the association that serves as the union of Major League baseball players in the United States and throughout the world, and represents the interests of professional baseball players who are members of teams in the American League and in the National League. Opposer’s principal purpose is to protect the rights of its members.
2. Opposer’s business activities include serving as the group licensing agent on behalf of, and representing certain collective commercial interests of, active Major League baseball players who are its members. As the group licensing agent, Opposer licenses, among

other things, the names of and marks owned by Opposer's members worldwide in connection with widely diversified products and services, including, but not limited to, apparel.

3. Aaron Judge ("Judge") is a member of Opposer.

4. Judge is a famous, widely known and highly regarded professional baseball player for the New York Yankees of Major League baseball who is the reigning American League Rookie of the Year, an All-Star, and a Silver Slugger Award recipient in the American League.

5. JUDGE is Judge's surname.

6. The name JUDGE is associated with the fame and reputation of Judge and points uniquely to Judge as a particular living individual. Accordingly, Judge has proprietary rights in his surname JUDGE, alone and with other terms.

7. The mark JUDGE, alone and with other terms (collectively, the "Judge Marks"), has been used as a trademark throughout the United States in connection with various goods and services, including apparel.

8. Opposer has the exclusive right to use, license and sublicense the names, nicknames, likeness, and certain other rights of Judge, including but not limited to the Judge Marks and Judge's name (collectively, the "Judge Property"), in various circumstances, including to commercially market those rights alone or on or in connection with products and services and has the right to enforce the rights in and to the Judge Property.

9. The Judge Marks have acquired strong nationwide common law rights, including in connection with apparel.

10. The Judge Marks have been used as trademarks on and in connection with the goods of Opposer's licensees, including apparel products, throughout the United States.

11. The Judge Marks have been continuously used prior to the filing date of the Application and have not been abandoned. The Judge Marks are symbolic of the extensive goodwill and consumer recognition built up through substantial amounts of time and effort in advertising, promoting and providing goods and services under these marks.

12. As a result of the use of the Judge Marks by Judge and Opposer, the purchasing public associates the Judge Marks, and the goods and services provided in connection with those marks, with Judge. The Judge Marks are distinctive and have become widely recognized by the consuming public as a designation of the source of Judge's goods and services and of Judge.

13. Upon information and belief, Applicant Michael P. Chisena is an individual with an address of P.O. Box 7169 Garden City, New York 11530 ("Applicant").

14. On July 14, 2017, Applicant filed the Application with the United States Patent and Trademark Office under 15 U.S.C. § 1051(b). The Application seeks registration of the mark HERE COMES THE JUDGE ("Applicant's Mark") for "clothing, namely, t-shirts, shirts, shorts, pants, sweatshirts, sweatpants, jackets, jerseys, athletic uniforms, and caps" in Class 25 (collectively, "Applicant's Goods").

15. This Notice of Opposition is being timely filed.

16. Upon information and belief, Applicant applied to register Applicant's Mark with full knowledge of the prior use and fame of the Judge Marks.

17. Upon information and belief, Applicant applied to register Applicant's Mark to trade on the significant goodwill associated with the Judge Marks and Judge's name.

18. There is no issue as to priority. Applicant's filing date for the Application, namely, July 14, 2017, or any date of first use upon which Applicant can rely is after the date when Opposer and Judge first used and acquired rights in the Judge name and Judge Marks.

19. Applicant's Mark is confusingly similar to the Judge Marks, and is applied to goods closely related to the goods and services offered by Judge and by Opposer.

20. Applicant's Mark so closely resembles the Judge Marks as to likely be confused and/or falsely associated therewith and mistaken therefor, and to lead consumers to mistakenly believe that Applicant's Goods emanate from, are affiliated with or are sponsored, endorsed or licensed by Judge and/or Opposer and/or falsely believe that there is a relationship between Applicant and Opposer or Judge. Applicant's Mark is deceptively similar to the Judge Marks so as to cause confusion and lead to deception as to the origin of Applicant's Goods bearing Applicant's Mark.

FIRST CLAIM FOR RELIEF
APPLICANT'S MARK COMPRISES THE NAME OF A PARTICULAR
LIVING INDIVIDUAL WITHOUT THAT INDIVIDUAL'S CONSENT

21. Opposer repeats and realleges each and every allegation set forth above.

22. Applicant's Mark incorporates the name JUDGE, which is the surname of Judge, a living individual who is generally and widely known, as he is a famous and high-profile professional ballplayer with the New York Yankees.

23. Applicant's Mark points uniquely to Judge as a particular living individual, and is associated with his fame and reputation.

24. Judge, and the JUDGE name, are also publicly connected or associated with clothing and the apparel field because his name is licensed for use on apparel.

25. Judge did not provide written consent to the registration of Applicant's Mark, and no such consent is of record.

26. Given the fame and recognition of Judge, the public would understand and recognize Applicant's Mark in connection with Applicant's Goods as identifying Judge and reasonably assume there is a connection between Applicant's Mark and Judge.

27. Applicant's Mark is not registrable pursuant to Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c) because it incorporates the name of a living individual without that individual's consent.

28. Opposer will be damaged if Applicant's Application is granted registration because Applicant will obtain statutory rights in Applicant's Mark in violation and derogation of the established prior rights of Opposer and Judge, the Judge Marks and Judge's identity will be weakened as a result, and the rights of Opposer and Judge to exploit the Judge Marks and Judge's name will be damaged.

**SECOND CLAIM FOR RELIEF
FALSE SUGGESTION OF A CONNECTION WITH OPPOSER**

29. Opposer repeats and realleges each and every allegation set forth above.

30. Applicant's Mark is likely to be confused with Judge's name and the Judge Marks.

31. Applicant's Mark contains Judge's surname and is also a close approximation of the Judge Marks, which were previously used by Opposer and Judge and are associated with Judge's identity, and Applicant's Mark would be recognized as such, in that it points uniquely and unmistakably to Judge.

32. Judge is not connected with the activities performed by Applicant in connection with Applicant's Mark.

33. The fame and reputation of Judge is such that, if Applicant's Mark is used in connection with Applicant's Goods, a connection with Judge would be presumed.

34. Upon information and belief, Applicant applied to register Applicant's Mark to trade on the goodwill associated with Judge's name and the Judge Marks.

35. Applicant's Mark is not registrable pursuant to Section 2(a) of the U.S. Trademark Act, 15 U.S.C. § 1052(a), because it falsely suggests a connection or affiliation with Judge.

36. Opposer will be damaged if Applicant's Application is granted registration because Applicant will obtain statutory rights in Applicant's Mark in violation and derogation of the established prior rights of Opposer and Judge, the Judge Marks and Judge's identity will be weakened as a result, and the rights of Opposer and Judge to exploit the Judge Marks and Judge's name will be damaged.

THIRD CLAIM FOR RELIEF LIKELIHOOD OF CONFUSION

37. Opposer repeats and realleges each and every allegation set forth above.

38. Opposer's and Judge's rights in the Judge Marks predate the filing date of Applicant's Application.

39. Applicant's Mark is highly similar in appearance and commercial impression to the Judge Marks.

40. The goods that are intended to be used by Applicant in connection with Applicant's Mark are closely related to the goods and services for which Opposer uses the Judge Marks, and would be promoted and sold or offered for sale in the same or similar channels of trade, to the same or similar purchasers.

41. In view of the similarity between the Judge Marks and Applicant's Mark and the closely related nature of the parties' goods and services, Applicant's Mark so resembles the Judge Marks as to be likely, when applied to Applicant's Goods, to cause confusion, or to cause mistake, or to deceive purchasers as to source by suggesting that Applicant's Goods are

associated with, or approved, sponsored, endorsed, authorized or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

42. The granting of a trademark registration for Applicant's Mark to Applicant would be contrary to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and would violate or diminish the prior and superior rights of Judge and Opposer in the Judge Marks.

43. The presumption of exclusivity that would arise from a registration to Applicant of Applicant's Mark is inconsistent with Judge's and Opposer's prior rights in the Judge Marks.

44. Opposer will be damaged if Applicant's Application is granted registration because Applicant will obtain statutory rights in Applicant's Mark in violation and derogation of the established prior rights of Opposer and Judge, the Judge Marks will be weakened as a result, and the rights of Opposer and Judge to exploit the Judge Marks will be damaged.

FOURTH CLAIM FOR RELIEF DILUTION

45. Opposer repeats and realleges each and every allegation set forth above.

46. In view of the strength of the Judge Marks, the duration and extent of nationwide use and advertising of the Judge Marks by Judge and Opposer, and the degree of recognition of the Judge Marks, the Judge Marks have become famous, as that term is used in 15 U.S.C. § 1125(c).

47. The Judge Marks were famous and distinctive prior to Applicant's July 14, 2017 filing date, and before any date of first use that may be alleged by Applicant.

48. Upon information and belief, Applicant applied to register Applicant's Mark with full knowledge of the prior use and fame of the Judge Marks.

49. Applicant's Mark is likely to dilute the distinctive quality of the Judge Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

50. Opposer will be damaged by the registration of Applicant's Mark because Applicant will obtain statutory rights in Applicant's Mark in violation and derogation of the established prior rights of Opposer and Judge, the Judge Marks will be weakened as a result, and the rights of Opposer and Judge to exploit the Judge Marks will be damaged. Therefore, registration of Applicant's Mark should be refused registration under 15 U.S.C. § 1125(c).

WHEREFORE, Opposer requests that this Opposition be sustained, and that the registration of Application Serial No. 87/528,440 be refused.

Dated: March 21, 2018

Respectfully submitted,

McCARTER & ENGLISH, LLP

By: /Lori J. Shyavitz/
Lori J. Shyavitz
Attorney for Opposer
MAJOR LEAGUE BASEBALL PLAYERS
ASSOCIATION
265 Franklin Street
Boston, Massachusetts 02110
Tel.: (617) 449-6500
Fax: (617) 607-9200
lshyavitz@mccarter.com